

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 2, 3, & 5 have been allowed.

Claims 1, 4, & 6 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hansen *et al.* (U.S. 5,956,625) in view of Deguchi (U.S. 5,793,619). For the following reasons, the rejection is respectfully traversed.

Claim 1 recites a “case body” and a “sliding cover” which is:

mounted and detached with respect to said case body by applying an outer force to said sliding cover in a direction perpendicular to a sliding direction when said sliding cover is positioned at a specific position within the sliding range

The Office action admits that Hansen does not suggest this element of claim 1. Deguchi has been cited for teaching this element of the claim. However, a close reading of Deguchi does not support this interpretation.

Claim 1 specifies that it is the *sliding cover* which is mounted and detached to the case body in a perpendicular direction. In contrast, the Daguchi teaches that its cover 3 is “slightly slid along the longitudinal direction” whereas a *separate* component, the “slide portion 10” is “formed in one side of the opening 1a along a direction perpendicular to this side surface.” (see col. 4, lines 37-67). Further, this “slide portion 10” is not taught as being mounted or detached in any manner whatsoever. It appears to merely slide in a manner to engage the cover 3 and lock it in place (*id.*). The passages cited by the Examiner do not teach any sliding cover being mounted or detached as recited in the claim. Instead, the cited passage clearly states that the cover may be “slid along the removing direction by depressing the operation portion downwardly”. Sliding along the removing direction, as shown in FIGURE 1 or 2, is in a direction *parallel* to the sliding direction, *not* perpendicular. Hence Daguchi clearly teaches *away* from the claim limitation.

The prior art reference(s) must teach or suggest *all* of the claim elements and/or claim

limitations to support an obviousness rejection (MPEP §2143.03). As discussed above, neither of the references suggest the cited element as limited by the language of claim 1. Accordingly, the combination of references do not make the claim limitations obvious, and thus claim 1 is patentable over the references.

Similarly, claim 4 recites that the sliding cover is:

mounted with respect to said case body by applying an outer force to said sliding cover when one of the sliding cover locking portions of said sliding cover is engaged with one of said locking portions of said case body and the other sliding cover locking portions is aligned in position on the other locking portion of said case body

As discussed above for claim 1, the slide portion 10 of Daguchi is slid parallel to the case, and thus no "outer force" is applied to the sliding cover itself. In fact, no "outer force" is suggested by any part of the operation taught by Daguchi.

Further, there is no suggestion found in either of the references that an outer force be applied when "one of the sliding cover locking portions is engaged" and the other locking portions is "aligned in position". Even if combined, there is no way for the references to teach this limitation of the claim. Ignoring this explicit language would make the limitation meaningless, which is cannot be done. See, e.g., *Exxon Chemical Patents Inc. v. Lubrizol Corp.* 35 USPQ2d 1801, 1808 (Fed. Cir. 1995) (stating that "we must give meaning to all words in [the] claim"); See also *Environmental Instruments, Inc. v. Sutron Corp.*, 11 USPQ2d 1132, 1134 (Fed. Cir. 1989) (stating that the words in a claim have meaning and must be given effect).

Consequently, claim 4 is not made obvious by the combination of the references, and hence claim 4 is patentable over the references. Claim 5, which depends on claim 4, is patentable for the same reasons as claim 4, and also for the limitations contained therein.

Claim 6, which recites the "outer force" language of claim 4, and also recites "distal ends" and "marks" in a similar manner as the "locking portions" of claim 4, is thus patentable over the reference for the same reasons as claim 4.

Finally, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is

some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (*Id.*).

The Examiner has cited no support for any such suggestion or motivation for the combination from within the references, and neither does the Examiner provide any references supporting any motivation to modify the reference(s) by making the combination. Conclusory statements of benefit, e.g., that the operability can be “improved” and that the operation can be executed “smoothly”, as provided by the Examiner in the Office action, are irrelevant; it is not sufficient to show obviousness, because merely listing an advantage of the combination is not sufficient, as some rationale for combining the references must be found *in the references themselves*, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself as is being done here, as such hindsight is impermissible; the facts must be gleaned from the *prior art*. (MPEP §2142, last paragraph).

Because the combination was not proper, the claim rejections for obviousness are improper, and hence the claims are patentable over the references.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

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If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 33045.

Respectfully submitted,

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